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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/361,678	07/27/1999	JONATHAN OLIVER	PA3639US	5818

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EXAMINER

CHANNAVAJJALA, SRIRAMA T

ART UNIT PAPER NUMBER

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DATE MAILED: 04/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/361,678	Applicant(s) OLIVER ET AL.	
	Examiner Srirama Channavajjala	Art Unit 2166	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-18, 20, 21 and 23-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-18, 20, 21 and 23-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Claims 1,3-18,20-21,23-34 are pending in this application
2. Claims 1,3-4,15,18,20-21,23,26-27,30,33-34 have been amended [12/21/2005].
3. Examiner acknowledges applicants' election filed on 7/12/2004, paper no.15
4. Claim 35 is hereby withdrawn from examination.

Drawings

5. The drawings filed on 12/21/2005 are acceptable for examination purpose.

Information Disclosure Statement

6. The information disclosure statement (IDS) submitted on 1/21/2000, 4/21/2000 considered, a copy of IDS is hereby enclosed with this office action, paper no. # 17.

However, the following IDS filed on **Jan 21,2000 are not received** for consideration. Applicant is hereby required to submit these IDS along with Author, title, date, pertinent pages, etc, in response to this office action.

- a) Bowne Internet Solution, "Personalization", 8 pages
- b) About Alta Vista, "Our technology", 2 pages
- c) Product Datasheet, "The open Sesame Profiling server, 2 pages
- d) Philip Chan, "A non-invasive Learning approach to building web user profiles, computer science, florida institute of technology 6 pages
- e) Biomar Larsen et al. « fast and effective text mining using linear time document clustering » SRA international,inc.pp 16-22

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- f) Susan Dumais, et al "Inductive learning algorithms and representations for text categorization," Microsoft research and computer science dept, Stanford univ, 8 pages.
- g) Lumeria, "an infomediary approach to the privacy problem," 22 pages
- h) Marko Grobelnik et al. "learning machine: design and implementation," department for intelligent systems, J.Stefan institute, Ljubljana, slovenia, pp 1-8
- i) Dunja Mladenic, "personal web watcher: design and implementation," department for intelligent systems, J.Stefan institute, Ljubljana, slovenia, pp 1-18.
- j) Andrew McCallum et al. « A comparison of event models for naive bayes text classification », 8 pages
- k) Myra Spiliopoulou, "The laborious way from data mining to web log mining", institut fur Wirtschaftsinformatik, Humboldt-Universitat zu Berlin, pp 1-21
- l) Data sheet, portal-in-a-box, autonomy's automated online information portal," product features, autonomy, inc 1 page, url=www.autonomy.com
- m) portal-in-a-box, product overview, autonomy, inc, 1 page, url=www.autonomy.com
- n) New Media, "Bringing full automation and true personalization to new media publishing," autonomy, inc. 8 pages, , url=www.autonomy.com
- o) autonomy technology white paper, autonomy, inc. 19 pages.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1,15,18,27,30,33-34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The invention as claimed in claims ***1,15,18,27,30,33,34*** and interpreted in light of the specification particularly page 4-5,8-11,12-17-18, fig 1,5-5, is directed to computer implemented recommendation software for documents or information based on user profile may have hardware and software or software per se, performing a mathematical algorithm, formula, or calculation related to "providing the user with recommended information by email, using the at least one recommendation software application.....user" [claim 1], "the user receiving, on the computer, by email a list of links to at least one document.....software application responsive to the transmitted content information" [claim 15]; "a market analysis method...receiving...determining...grouping....summarizing...deriving, using a computer....utilizing the interest profile, using a computer, to generate a personalized recommendation.....user is accessed by the user using an email" [claim 18]; "A method of using a computer to customize information....(a) tracking requests....(b) extracting filtered content....(c) analyzing the filtered content of the(d) constructing a profile of the user..... (e) determining, based on the user profile,.....(f) providing the user with recommended.....of the user" [claim 27, claim 30]; "A system for providing personalized information to a user comprising: a memory....a processor in

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communication....extract filtered content...analyze the filtered content....determine the theme or concept....cluster the at least first.....construct a profile of the user....determine the interests of the user....categorize at least second document....recommend to the user[claim 34] and as such the claimed invention is subject to the test of State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02.

Specifically State Street sets forth that the claimed invention must produce a ***“useful, concrete and tangible result.”*** The Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility states in section IV C: 2 b. (2) (on page 21 in the PDF format):

The tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. However, the tangible requirement does require that the claim must recite more than a § 101 judicial exception, in that the process claim must set forth a practical application of that § 101 judicial exception to produce a real-world result. Benson, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had “no substantial practical application.”).

Claims **1,15,18,27,30,33-34** have the result of producing real-world results, however the claims do not specify that the result neither stored nor output is displayed to a user or otherwise used in the real world, is not a positive recitation of a real world result, especially claim **1,15,18,27,30,33-34**, although for example claim 1 “storing in a database, information regarding each document tracked by tracking module”, but **does not output useful, concrete and tangible** . Thus the claimed result is not tangible and thus the claimed result is not a “useful, concrete and tangible result.” The court in State Street noted that the claimed invention in Alappat constituted a practical application of an abstract idea because it produced *a useful, concrete and tangible result* the display of a smoothed heart beat to a system user. The Federal Circuit further ruled that it is of

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little relevance whether a claim is directed to a machine or process for the purpose of a § 101 analysis. AT&T, 172 F.3d at 1358, 50 USPQ2d at 1451 (see the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, Annex II).

The examiner reviewed the specification but was unable to find a practical real-world use of the result (for example: claim 18, "utilizing the interest profile.....user using an email"; recommend to the user by email the at least second categorized document in claim 34). If the applicant is able to find one and inserts it into the claims provide the location the element[s] is found in the specification.

In the above analysis of claims 3-14, 16-17, 20-21, 23-26, 28-29,31-32 dependent claims 1,15,18,27,30 also rejected on that basis.

See for further information: <<http://www.uspto.gov/web/offices/pac/dapp/ogsheet.html>>

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 27 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. At page 6, claim 27, item (d) reads "constructing a profile of the user "frolll" the analyzed content". It appears the "frolll" is typo error. Examiner assumes the correct word to be "from", and treats as "from", in the present office action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

10. Claim 1-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Jacobi et al., [hereafter Jacobi], US Patent No. 6317722.

11. As to Claim 1, Jacobi teaches a system which including 'creating a personalized display for a user' [see fig 6, col 8, line 24-25], 'creating a database entry for each user of a client document server using a tracking module' [col 7, line 45-47, line 49-50, fig 1, fig 3], creating database entry corresponds to Jacobi's fig 1, element 64, document

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server corresponds to Jacobi's web server, fig 1, element 32, particularly fig 3 details number of relational tables created in the database;

'tracking requests by the user for at least one document on a client document server using the tracking module' [col 3, line 43-48, col 7, line 65-67, col 8, line 1-6];

'storing, in a database, information regarding each document tracked by the tracking module' [col 7, line 45-58];

'analyzing the stored information to construct a profile of the user'
[col 9, line 41-51];

'determining based on the user profile [col 7, line 45], using the at least one recommendation software application, the interests of the user' [col 7, line 49-54, line 59-64, col 10, line 46-51, fig 1], Jacobi specifically teaches "user profiles" database stores specific information about "user profiles" for example as detailed in fig 1, element 38, further based on user's purchase history, lists of items present and past history ie., purchase history, recommendation service [fig 1, element 44] generates recommendations that are specific to a particular shopping cart as detailed in col 7, line 58-64, col 10, line 46-51],;

'providing the user with recommended information by email using the at least one recommendation software application, based upon the determined interests of the user [fig 2, col 12, line 9-12], Jacobi specifically teaches recommendations are being sent to user by email, facsimile, or ther transmission method as detailed in fig 2, col 12, line 9-12.

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12. As to Claim 3, most of the limitations of this claim have been noted in the rejection of Claim 1 above. In addition, with respect to the claimed feature Jacobi disclosed 'recommended information is selected from the group consisting of recommendation documents and recommendation packages' [col 5, line 57-67, col 6, line 1-1-6].

13. As to Claim 4, most of the limitations of this claim have been noted in the rejection of Claim 1 above. In addition, with respect to the claimed feature Jacobi disclosed 'recommended information is selected from the group consisting of advertisements, products, animations, graphic displays, sound files, applets, and services' [col 4, line 66-67, col 5, line 1-10, col 12, line 10-13], Jacobi specifically teaches recommended information such as web sites, chat groups, movies, television shows, downloadable contents, book titles, video titles and like as detailed in col 5, line 1-10.

14. As to Claim 5, most of the limitations of this claim have been noted in the rejection of Claim 1 above. In addition, with respect to the claimed feature Jacobi disclosed 'sending a user-identifier to the user's computer using the tracking module' [col 7, line 1-9]; 'sending the user-identifier and a document identifier to the database when the user moves to different document in the client's document server using the tracking module' [col 7, line 45-58].

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15. As to Claim 6, most of the limitations of this claim have been noted in the rejection of Claim 1 above. In addition, with respect to the claimed feature Jacobi disclosed 'stored information comprises content information' [col 7, line 53-58, fig 1].

16. As to Claim 7, most of the limitations of this claim have been noted in the rejection of Claim 1 above. In addition, with respect to the claimed feature Jacobi disclosed 'client document server is a web site' [see fig 6, col 8, line 66-67].

17. As to Claim 8, most of the limitations of this claim have been noted in the rejection of Claim 1 above. In addition, with respect to the claimed feature Jacobi disclosed 'tracking module comprises embedded HTML links to the marketing system' [col 8, line 60-67, col 9, line 1-3].

18. As to Claim 9, most of the limitations of this claim have been noted in the rejection of Claim 1 above. In addition, with respect to the claimed feature Jacobi disclosed 'parsing, using the at least one recommendation software application, a set comprising information regarding at least one document viewed by the user' [col 10, line 46-51];

'determining, using the at least one recommendation software application, at least one common theme or concept of the set' [col 10, line 63-67, col 11, line 1-4];

'clustering into interest folders, using the at least one recommendation software application, the at least one document in the set according to the number of common themes or concepts in the at least one document' [col 11, line 40-45, line 62-65].

19. As to Claim 10, most of the limitations of this claim have been noted in the rejection of Claim 9 above. In addition, with respect to the claimed feature Jacobi disclosed 'categorizing at least one document, using the at least one recommendation software application, according to the common themes or concepts of the interest folders' [col 12, line 4-13].

20. As to Claim 11, most of the limitations of this claim have been noted in the rejection of Claim 10 above. In addition, with respect to the claimed feature Jacobi disclosed 'recommending to the user, using the at least one recommendation software application, the at least one categorized document' [col 12, line 39-48], categorized documents based on product ids as detailed in table 60.

21. As to Claim 12, most of the limitations of this claim have been noted in the rejection of Claim 1 above. In addition, with respect to the claimed feature Jacobi disclosed 'analyzing step further comprises the step of using at least a first filter to extract selected content from each document tracked by the tracking module' [col 11, line 50-61], Jacobi specifically teaches filtering process as detailed in fig 2-3.

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22. As to Claim 13, most of the limitations of this claim have been noted in the rejection of Claim 12 above. In addition, with respect to the claimed feature Jacobi disclosed 'at least a second filter to extract structure information from within the extracted content' [see fig 2-3, col 14, line 1-7].

23. As to Claim 14, most of the limitations of this claim have been noted in the rejection of Claim 9 above. In addition, with respect to the claimed feature Jacobi disclosed 'summarizing each interest folder, using the at least one recommendation software application, to determine at least one keyword from the at least one document in the interest folder' [fig 1, col 7, line 65-67, col 8, line 1-2], Jacobi specifically teaches search engine enabling users to query items or purchase items or simily search shopping catalog that uses key words or phrases and like.

24. As to Claim 15, Jacobi teaches a system which including 'a user viewing' [col 6, line 57-59]; 'using a computer' [see fig 1], a document from a client document server, the document containing internal content information' [see fig 1, fig 6, col 5, line 19-24];

'the client document server transmitting, using a computer, the internal content information of the viewed document to at least one recommendation software application' [see fig 1, col 7, line 34-44];

'the user receiving, on the computer, by email a list of links to at least one document recommended by the at least one recommendation software application responsive to the transmitted internal content information' [fig 1, fig 6, col 12, line 9-13, line 57-60, col 8, line 63-67, col 10, line 56-60, col 16, line 6-14].

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25. As to Claim 16, most of the limitations of this claim have been noted in the rejection of Claim 15 above. In addition, with respect to the claimed feature Jacobi disclosed 'storing, using a computer, the internal content information in a database' [col 7, line 49-55].

26. As to Claim 17, most of the limitations of this claim have been noted in the rejection of Claim 16 above. In addition, with respect to the claimed feature Jacobi disclosed 'analyzing, using a computer, the internal content information in the database to determine a profile of the user, wherein the profile is used to recommend the list of links' [fig 1 col 7, line 45-64], Jacobi specifically teaches database that stores user profile for example as detailed in fig 1, element 38, further user profile, purchase history determines for recommending items.

27. As to Claim 18, Jacobi teaches a system which including 'receiving, on a computer, internal content information of at least one document accessed by a user' [see fig 1, fig 6, col 7, line 30-41, line 65-67, col 8, line 1-2], Jacobi specifically teaches user computer(s) are connected through internet for example a search engine connected to a database;

'determining, using a computer, the theme and concepts of the at least one document' [col 8, line 7-17], Jacobi specifically teaches users personal shopping cart that processes the personal list, generating, maintaining user specific items;

'grouping, using a computer, the at least one documents into at least one interest folder according to common themes and concepts' [col 8, line 26-30];

'summarizing, using a computer, the at least one interest folder to extract at least one keyword representing the common themes and concepts of the interest folder' [col 8, line 63-67, col 9, line 1-7].

'deriving, using a computer [see fig 1, element34], an interest profile from the user's at least one interest folder' [col 8, line 44-48];

'utilizing the interest profile, using a computer, to generate a personalized recommendation package for the user [col 8, line 51-59, col 10, line 56-62] , wherein the personalized recommendation package for the user is accessed by the user using an email' [col 10, line 56-60, col 12, line 9-11], Jacobi specifically teaches recommendations are generated and sent to the user by "e-mail" listing that contain hyperlinks to the product information pages of the recommended items as detailed in col 10, line 56-60

28. As to Claim 20, most of the limitations of this claim have been noted in the rejection of Claim 18 above. In addition, with respect to the claimed feature Jacobi disclosed 'using a computer, the user's profile in accordance with instructions provided by the user' [col 10, line 63-67, col 11, line 1-4].

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29. As to Claim 21, most of the limitations of this claim have been noted in the rejection of Claim 18 above. In addition, with respect to the claimed feature Jacobi disclosed 'utilizing the interest profile, using a computer, to locate documents for recommendation to the user' [col 11, line 21-27].

30. As to Claim 23-24, most of the limitations of this claim have been noted in the rejection of Claim 18, above. In addition, with respect to the claimed feature Jacobi disclosed 'personalized recommendation package is presented on a personalized web start page that is accessed using an email' [fig 6, col 8, line 22-25, col 12, line 9-12, col 16, line 6-14].

31. As to Claim 25, most of the limitations of this claim have been noted in the rejection of Claim 24 above. In addition, with respect to the claimed feature Jacobi disclosed "Uniform Resource locator associated with the personalized web start page in the form of a link to the client document server' [col 8, line 22-25].

32. As to Claim 26, most of the limitations of this claim have been noted in the rejection of Claim 18 above. In addition, with respect to the claimed feature Jacobi disclosed 'using a computer, syndicated information to the user in response to the user's profile' [col 8, line 55-59].

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33. Claim 27-32,34 are rejected under 35 U.S.C. 102(e) as being anticipated by Adar et al [hereafter Adar], US Patent No. 6493702.

34. As to Claim 27, 30, Adar teaches a system which including 'customize information provided to a user over an electronic network' [see Abstract, fig 1];

'(a) tracking requests by a user of a client document server for at least a first requested document on the client document server' [col 3, line 45-54, line 55-62];

'(b) extracting filtered content from the at least first requested document' [col 6, line 9-19]

'(c) analyzing the filtered content of the at least first requested document' [col 6, line 42-54];

'(d) constructing a profile of the user from the analyzed content' [col 13, line 17-26];

'(e) determining, based on the user profile, the interests of the user' [col 13, line 66-67, col 14, line 1-4].

(f) 'providing the user with recommended information by email based upon the determined interests of the user' [col 8, line 10-12, col 12, line 41-47, col 14, line 14-24, fig 14], Adar teaches in the user's preferences, more specifically user preferences including "password, "e-mail" address" [see col 8, line 11-12], further, Adar also teaches based on user's collection of bookmarks or user's preference, Adar's system tracks metrics that allows searching and recommendation operations [col 12, line 41-47], also "recommendation service is fully detailed in fig 14, col 14, line 18-24

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35. As to Claim 28, 31, most of the limitations of this claim have been noted in the rejection of Claim 27 above. In addition, with respect to the claimed feature Adar disclosed 'determining the theme or concept of the at least first requested document' [col 13, line 7-12];

'clustering the at least first requested document into at least one interest folder according to the theme or concept in the document' [col 13, line 40-48];

'categorizing at least a second document, according to the theme or concept of the at least one interest folder' [col 17, line 9-15];

'recommending to the user the at least second categorized document' [see fig 14, col 14, line 18-27].

36. As to Claim 29,32, most of the limitations of this claim have been noted in the rejection of Claim 28 above. In addition, with respect to the claimed feature Adar disclosed 'summarizing the at least one interest folder to extract at least one keyword representing the theme or concept of the interest folder' [col 13, line 7-12];

'searching the at least second document for the at least one keyword to categorize the at least second document' [col 13, line 66-67, col 14, line 1-9].

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37. As to Claim 34, Adar teaches a system which including 'a memory device having embodied therein information relating to at least one electronic document viewed by the user' [see fig 2];

'a processor in communication with the memory device, the processor configured to 'extract filtered content from the at least first viewed document' [[col 6, line 9-19]

'analyze the filtered content of the at least first viewed document' [col 6, line 42-54];

'determine the theme or concept of the at least first viewed document' [col 13, line 66-67, col 14, line 1-4];

'cluster the at least first requested document into at least one interest folder according to the theme or concept in the document' [col 13, line 40-48];

'construct a profile of the user from the analyzed content' col 13, line 17-26];

'determine the interests of the user based on the user profile [col 14, line 37-42].

'categorize at least second document, according to the theme or concept of the at least one interest folder' [col 17, line 9-15, line 36-41]; Adar specifically teaches document collection scheme, particularly arranged in hierarchy , therefore, Adar teaches multiple documents with topic reference, arranged in hierarchy of categories as detailed in col 17, line 36-41

'recommend to the user by email the at least second categorized document' [col 12, line 41-47, col 14, line 14-24, fig 14], Adar teaches in the user's preferences, more specifically user preferences including "password, "e-mail" address" [see col 8, line 11-12], further, Adar also teaches based on user's collection of bookmarks or user's

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preference, Adar's system tracks metrics that allows searching and recommendation operations [col 12, line 41-47], also "recommendation service is fully detailed in fig 14, col 14, line 18-24

38. Claim 33 is rejected under 35 U.S.C. 102(e) as being anticipated by Boe et al., [hereafter Boe] US Patent No. 6236975.

39. As to Claim 33, Boe teaches a system which including 'a marketing system comprising at least a first computer with at least one recommendation software application operable thereon' [see Abstract, fig 1, col 3, line 2-6, line 9-12, col 4, line 31-38], Boe specifically teaches targeted marketing system using computer network as detailed in fig 1, first computer corresponds to fig 1, element 14;

'at least a second computer with at least one client document server operable thereon' [col 4, line 46-60], Boe specifically teaches customized reports from the business system element 14, further this business system is connected to the survey system typically have business survey reports that corresponds to document server, second computer corresponds to Boe's fig 1, element 12;

'at least a third computer operable to receive and display to a user at least one document from the client document server' [col 4, line 61-67, col 5, line 1-3, fig 4b-4f];

'a tracking module associated with the at least one client document server to track the display of the at least one document to the user and to provide information

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regarding the at least one document to the marketing system' [see fig 4c,4e,col 10, line 9-33];

'at least one database accessible to the marketing system to store information associated with the at least one document displayed by the user' [col 10, line 51-67,col 11, line 1-6], database corresponds to Boe's fig 1, element 24;

'wherein the recommendation system is operable to analyze the information stored in the database to determine a profile of the user' [col 10, line 60-67,col 11, line 1-6, col 11, line 53-67].

'wherein the recommendation system is operable to recommend documents to the user in response to the determined profile' [fig 5a-b, col 14, line 44-53], Boe specifically suggests, once customer has selected specific required criteria, customer selected criteria is compared with matching database to provide specific recommendation(s) to the customer;

'wherein the recommendation system is operable to provide a personalized recommendation package to the user by email in response to the determined profile' [col 14, line 44-67,, col 15, line 1-7], Boe specifically suggests, matching database based on customer submitted information or data and allows business system to generate reports or recommendation package based on customer profile, more specifically customer's identification number as detailed in col 15, line 1-7, further Boe also suggestsets automatically prepare and transmit an e-mail to the business [see col 14, line 67].

Response to Arguments

40. Applicant's arguments with respect to claims 1,3-18,20-21,23-34 filed on 21 December 2005 have been fully considered, for examiner's response see discussion below.

In response to Applicant's amendment and remarks, concerning the 35 USC 102(e) rejection of claims 1-26, as being clearly anticipated by ***Jacobi US Patent No. 6317722***, examiner notes the following:

It is noted that Applicant's remarks, at pages 10-12 of the response, are merely conclusory statements, without any support. Applicant is merely repeating the language of the claim, without addressing Examiner's particular interpretation of the reference, as presented in the previous Office action, and without specifying how the instant amendments address the issue raised by the Examiner.

It is also noted in the "REMARKS", at page 11-12, claims 27,30, 34 applicant's arguments are directed to "Jacobi et al." reference. In the previous office action, **examiner rejected Claim 27-32,34 under 35 U.S.C. 102(e) as being anticipated by Adar et al., US Patent No. 6493702**

Further, in the remarks, at page 12, claim 33, applicant's arguments are directed to ""Jacobi et al." reference, however, in the previous office action, **examiner rejected Claim 33 under 35 U.S.C. 102(e) as being anticipated by Boe et al., US Patent No. 6236975.**

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a) At page 11, claim 1, applicant argues that Jacobi does not teach “creating a database entry for each user of a client document server using a tracking module;.....tracking module”, or “providing the user with recommended information by email”

As to the argument [a], examiner disagree with the applicant because firstly, Jacobi et al is directed to “generating personal recommendations”, more specifically Jacobi teaches “user profile” database containing information related to user’s purchase histories, item ratings, recent shopping items and like as detailed in fig 1, element 38, further it is noted that “user profiles” database stores individual user information that including purchase history as detailed in col 7, line 45-54. It is also noted that Jacobi specifically teaches server connected to access, interactively search catalog or items related to web sites and preserving such information that allows “recommendation service” to generate recommendations to the user[s] as detailed in col 3, line 43-48, col 7, line 65-67, col 8, line 1-6, therefore, Jacobi teaches not only creating database entries for users, ie., “user profile”, but also server or web server tracking catalog or documents related to specific items to the users.

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b) At page 11, claim 15, applicant argues that Jacobi does not teach “receiving”, on the computer, by email a list of links to at least one document recommended by the at least one recommendation software application responsive to the transmitted content information”.

As to the argument [b], examiner disagree with the applicant because firstly, Jacobi specifically teaches “computer-implemented “personal recommendation”, particularly, user[s] connected to the network using “internet” as detailed in fig 1, abstract; secondly, Jacobi specifically teaches generating recommendations automatically displayed to the user[s] in the shopping cart contents [col 6, line 57-60], further, Jacobi also teaches “recommendation service” specifically used to recommend Web sites, the items (web sites) that corresponds to web documents to the user[s] [see col 8, line 63-67], thirdly, Jacobi teaches the “recommendations can be automatically be generated and sent to the user by “e-mail” listing that may contain hyperlinks to the product information pages as detailed in col 10, line 56-60. Since applicant has not specified how the amended language distinguishes the claimed invention from Jacobi et al. beyond simply asserting that it does without any further support, Examiner is unable to determine how the above-noted language distinguishes the claimed invention from at least these citations from the Jacobi et al. as detailed above.

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c) At page 11, claim 18, applicant argues that “Jacobi does not teach generating “ a personalized recommendation package for the user, wherein the personalized recommendation package for the user is accessed by the user using an email”.

As to the argument [c], examiner disagree with the applicant because Jacobi teaches “personal recommendations” [see Abstract], particularly, generating recommendations in real-time and displaying to the user on the same Web page [col 10, line 46-51, col 12, line 9-11], further these generated recommendations are sent to the user by “e-mail” listing that contains hyperlinks to the product information pages of the recommended items as detailed in col 10, line 56-61

d) At page 11, claim 27,30 applicant argues that Jacobi does not teach “providing the user with recommended information by email”

As to the above argument, **examiner rejected Claim 27-32,34 under 35 U.S.C. 102(e) as being anticipated by Adar et al., US Patent No. 6493702.**

Adar teaches in the user's preferences, more specifically user preferences including “password, “e-mail” address” [see col 8, line 11-12], further, Adar also teaches based on user's collection of bookmarks or user's preference, Adar's system tracks metrics that allows searching and recommendation operations [col 12, line 41-47], also “recommendation service is fully detailed in fig 14, col 14, line 18-24.

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e) At page 12, claim 33, applicant argues that Jacobi does not teach that “the recommendation system is operable to recommend documents to the user in response to the determine profile”.....personalized recommendation package for the user”

As to the above argument [e], ***Claim 33 is rejected under 35 U.S.C. 102(e) as being anticipated by Boe et al., US Patent No. 6236975.***

As noted above, Boe specifically suggests, matching database based on customer submitted information or data and allows business system to generate reports or recommendation package based on customer profile, more specifically customer's identification number as detailed in col 15, line 1-7, further Boe also suggests automatically prepare and transmit an e-mail to the business [see col 14, line 67].

f) At page 12, claim 34, applicant argues that Jacobi does not teach categorizing “at least second document, according to the theme or concept of the at least one interest folder” and recommending “to the user by email the at least second categorized document”

As to the above argument [f], ***Claim 27-32,34 are rejected under 35 U.S.C. 102(e) as being anticipated by Adar et al], US Patent No. 6493702***

As noted above, Adar specifically teaches document collection scheme, particularly arranged in hierarchy , therefore, Adar teaches multiple documents with topic reference, arranged in hierarchy of categories as detailed in col 17, line 36-41;

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Furthermore, Adar teaches user's preferences, more specifically user preferences including "password, "e-mail" address" [see col 8, line 11-12], , Adar also teaches based on user's collection of bookmarks or user's preference, Adar's system tracks metrics that allows searching and recommendation operations [col 12, line 41-47], also "recommendation service is fully detailed in fig 14, col 14, line 18-24

g) At page 10, examiner noted applicant's response to the claims 18,30,33-34 under 35 USC 101.

The examiner reviewed the specification but was unable to find a practical real-world use of the result (for example: claim 18, "utilizing the interest profile...user using an email"; recommend to the user by email the at least second categorized document in claim 34). If the applicant is able to find one and inserts it into the claims provide the location the element[s] is found in the specification.

In the above analysis of claims Claims 1,15,18,27,30,33-34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

See for further information: <<http://www.uspto.gov/web/offices/pac/dapp/ogsheet.html>>

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Conclusion

The prior art made of record

- a. US Patent No. 6236975
- b. US Patent No. 6317722
- c. US Patent No. 6493702

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure

- d. US Patent No. 6202083
- e. US Patent No. 6654735
- f. US Patent No. 6125173
- g. US Patent No. 6345293
- h. US Patent No. 6029141
- i. US Patent No. 6484149
- j. US Patent No. 5727129
- k. US Patent No. 6692359
- l. US Patent No. 5978799
- m. US Patent No 6202083
- n. US Patent No 6202083
- p. WO98/57490
- q. Qi et al., Efficient profile matching for large scale

webcasting, computer networks and ISDN systems, 30, 1998 pp 443-455

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r. . . Hidekazu S, et al. Learning personal preferences on online newspaper articles from user behaviors, computer networks and ISDN systems 29, 1997 pp 1447-1455

s. . . Christian K et al. WebAssist : a user profile specific information retrieval assistant, short paper, computer networks and ISDN systems, 30 1998, pp 654-655.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Srirama Channavajjala whose telephone number is 571-272-4108. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alam, Hosain, T, can be reached on (571) 272-3978. The fax phone numbers for the organization where the application or proceeding is assigned is 571-273-8300 Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free)

SC
Patent Examiner.
April 5, 2006.


SRIRAMA CHANNAVAJJALA
PRIMARY EXAMINER